

REMARKS

In the instant application claims 1-4, 6-9, 11, 12, 15, 18-20, 23, 24, 26-32, 34-38 and 40-42 were pending. Claims 5-8, 10-22, 25-28 and 30-42 have been cancelled without prejudice. Claims 1-4 and 9 are withdrawn. Claims 1, 9, 23, 24 and 29 have been amended and claims 43 and 44 are new. Claims 9, 23, 24 and 29 have been amended to clarify the invention. After entry of the instant amendment claim 23, 24, 29 43 and 44 will be pending.

No new matter has been added. Support for the amendments to the claims and the new claims can be found throughout the specification and claims as originally filed. For example, support for the amendments to claim 1 can be found, at least, in originally filed claim 8. Support for new claim 43 can be found, at least, in originally filed claim 23. Support for new claim 44 can be found, at least, in Table I, found on pages 9-11 of the originally filed specification.

It is Applicants' understanding that once the elected compound claims are found to be allowable, withdrawn method claims will be considered for rejoinder.

Cancellation of and/or amendments to the claims should in no way be construed as acquiescence to the Examiner's rejections. The cancellation of and/or amendments to the claims are being made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in the present or another patent application. The cancellation of and/or amendments to the claims are not related to any issues of patentability.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 23, 24 and 27-29 under 35 U.S.C. § 102(e) as being anticipated by Suto (US Pub. No. 2004/0180889). Applicants note that this rejection has been rendered moot with regard to cancelled claims 27 and 28.

Without acquiescing to the examiner's characterization of the claims and solely in an effort to expedite prosecution, claims 23, 24 and 29 have been amended, thereby obviating this rejection.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 23, 24 and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over Gerlach (US Patent No. 6,699,877B2). Applicants note that this rejection has been rendered moot with regard to cancelled claims 27 and 28. In this rejection the Office

Action asserts that it would have been obvious to have selected various combinations of various substituents from within Gerlach, to arrive at the compounds that are encompassed by the compounds of formula 1-a*. Applicants respectfully disagree with this rejection for at least the following reasons.

From the outset, Applicants note that Gerlach does not teach or suggest the compounds in the genus of claim 23, and further fails to teach or suggest the specific compounds set forth in claim 29.

As the Federal Circuit set forth in *Takeda Chem. Indust. V. Alphapharm Pty., Ltd.*, the case law concerning *prima facie* obviousness of structurally similar compounds is well settled.¹ Specifically, the Court, citing *In re Dillon*, states that “structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness.”² However, the court in *Takeda* goes on to clarify this finding by stating that in order to find a *prima facie* case of unpatentability in cases of structurally similar compounds, “a showing that the ‘prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention’ was also required.”³ The *Takeda* court further states that “in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound.”⁴

Applicants respectfully submit that there is nothing in Gerlach to suggest to one of skill in the art to select any compound disclosed in Gerlach out of the numerous compounds disclosed, as the best performing compound, and therefore, a target for further modification to improve properties.

Comparable to *Takeda*, Gerlach discloses a broad number of compounds without identifying any predictable solutions to enhance biological activity, efficacy or safety of such compounds, and any one of the broad number of compounds disclosed in this patent could have been selected for further modification. Moreover, Gerlach does not provide any suggestion or motivation to select any compound disclosed within it for further modification.

¹ *Takeda Chem. Indust. v. Alphapharm Pty., Ltd.* 492 F.3d 1350 (Fed. Cir. 2007).

² *Id.* at 1356.

³ *Id.* at 1356 (emphasis added), citing *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992); *In re Dillon* 919 F.2d 688 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729 (Fed. Cir. 1985) and *In re Lalu* 747 F.2d 703 (Fed. Cir. 1984).

⁴ *Id.* at 1357 (emphasis added).

In view of the foregoing, Applicants submit that claims 23, 24 and 29 are patentable over Gerlach because this patent fails to provide motivation for arriving at the instantly claimed compounds. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

SUMMARY

It is respectfully submitted that this application is in condition for allowance. If there are any remaining issues or the Examiner believes that a telephone conference with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 449-6510.

Applicants believe no fees are due with this response. However, if any additional fees are due, please charge our Deposit Account No. 50-4876, under Order No. 118410-00301 from which the undersigned is authorized to draw.

Dated: September 8, 2010

Respectfully submitted,

By Elizabeth A. Hanley
Elizabeth A. Hanley
Registration No.: 33,505
McCarter & English, LLP
265 Franklin Street, 14th Floor
Boston, Massachusetts 02110
(617) 449-6510
Fax (617) 607-9200
Attorney/Agent For Applicants